

REMARKS

In response to the Office Action dated March 1, 2004, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance. At the outset, Applicants and the undersigned express their appreciation to Examiner Gravini for the courtesies extended during the telephonic interview of May 4, 2004.

In the Office Action, claims 13-20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-12 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by EP 0 964 542 to Kulakowski et al. Claims 13-20 were further rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 6,122,520 to Want et al., or U.S. Patent No. 6,133,853 to Obradovich et al. Claims 1-20 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over the Examiner's personal experience. Additionally, claims 1-20 were provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-20 of co-pending Application No. 09/740,373. Applicants respectfully traverse each rejection.

Applicants have herein amended claim 13 to clarify that, "the plurality of location-specific advertisements are stored in a format selected from the group consisting of at least a digital audio format and a digital text format."

Rejections under 35 U.S.C. § 101

In the Office Action, claims 13-20 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. (See Office Action at p. 5.) Applicants submit that claims 13-20 as originally submitted are clearly directed to statutory subject matter. To expedite prosecution, however, Applicants have amended claim 13 as described below.

The Office Action suggests that claim 13 was “not tied to any technological art.” (See Office Action at p. 6.) Applicants submit that claim 13 is directed to the technological arts. For example, claim 13 as originally filed recited, “sending the one of the plurality of location-specific advertisements to the wireless communication device over the communication network . . .” Applicants submit that wireless communication devices and communication networks are components of telecommunications systems and are clearly within the technological arts. Therefore Applicants submit that claim 13 and its dependent claims 14-20 are within the technical arts as originally filed.

Applicants next submit that claim 13 recites a useful, concrete and tangible result, is enabled, and is not merely an abstract concept. The Office Action suggested that the limitations of claim 13 did not, “produce a concrete result because a result cannot be assured or is not reproducible.” (See, Office Action at p. 5.) Further, the Office Action appeared to characterize the limitations of claim 13 as “an abstract concept that is non-enabling because a result cannot be assured such that one skilled in the art would be able to achieve a reproducible result.” Applicants traverse these statements, and note that claim 13 recites, for example, “sending the one of the plurality of location-specific advertisements to the wireless communication device

over the communication network without transmitting the identity of the user therewith.” (*See* Office Action at p. 5.) As such, a result (e.g. providing an advertisement to a wireless communication device) can be assured, and is reproducible by one skilled in the art. Therefore, Applicants submit that claim 13 and its dependent claims 14-20 provide a useful, concrete and tangible result, are enabled, and are not merely an abstract concept.

Despite Applicants’ position that claim 13 recites statutory subject matter as originally filed, Applicants have herein amended claim 13 to expedite prosecution. Amended claim 13 now recites, “searching a database containing a plurality of location-specific advertisements wherein the plurality of location-specific advertisements are stored in a format selected from the group consisting of at least a digital audio format and a digital text format.” Applicants submit that storing data in a digital audio format or a digital text format is clearly within the technological arts. Also, Applicants note that this amendment complies with a suggestion made by the Examiner in the interview of May 4, 2004.

Rejections under 35 U.S.C. § 103(a)

In the Office Action, claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Examiner’s personal experience. (*See* Office Action at p. 8.) Applicants respectfully traverse the rejections. Applicants also note that the Examiner indicated during the interview of May 4, 2004, and in the Interview Summary mailed on May 5, 2004, that the rejections of claims 1-20 under 35 U.S.C. § 103(a) are withdrawn.

Rejections under 35 U.S.C. § 102(b)

In the Office Action, claims 1-12 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by EP 0 964 542 to Kulakowski et al. (*See* Office Action at p. 7.) An anticipation rejection is proper, “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (*See* MPEP § 2131.) Applicants submit that Kulakowski fails to disclose at least, “sending the first one of the plurality of location-specific advertisements to the wireless communication device in the form of a first TCP/IP (Transmission Control Protocol/Internet Protocol) message over a communication network,” as recited in claim 1. To the contrary, Applicants submit that Kulakowski does not teach any specific transmission protocol. Therefore, Applicants submit that claim 1 is not anticipated by Kulakowski.

Applicants also traverse the rejections of claims 2-12 under 35 U.S.C. § 102(b) as being clearly anticipated by Kulakowski. Applicants submit that claims 2-12 are allowable by virtue of their dependence from independent claim 1 as well as on their own merit.

Claims 13-20 were further rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 6,122,520 to Want et al. (*See* Office Action at p. 7.) Applicants submit that Want fails to teach at least, “receiving second information about the identity of the user,” as recited in amended claim 13. The Examiner stated in the interview of May 4, 2004 that this feature of amended claim 13 read on the distributed network of Want. (*See* Want at col. 3, ln. 30.) Applicants submit that, even though it discloses a distributed network, Want does not

disclose, expressly or inherently, “receiving second information about the identity of the user,” as recited in amended claim 13. Therefore, Applicants submit that amended claim 13 is not anticipated by Want.

Applicants also traverse the rejections of claims 14-20 under 35 U.S.C. § 102(b) as being clearly anticipated by Want. Applicants submit that claims 14-20 are allowable by virtue of their dependence from independent claim 13 as well as on their own merit.

Claims 13 to 20 were also rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 6,133,853 to Obradovich et al. (See Office Action at p. 7.) Applicants submit that Obradovich fails to disclose, at least, “receiving second information about the identity of the user,” as recited in amended claim 13. The Examiner stated in the interview of May 4, 2004 that this feature of amended claim 13 read on the Personal Communications Devices (PCD’s) of Obradovich. (See Obradovich at col. 2, ln. 19.) Applicants submit that Obradovich fails to disclose that PCD’s may send, or any device may receive “information about the identity of the user,” as recited in amended claim 13. Therefore, Applicants submit that amended claim 13 is not anticipated by Obradovich.

Applicants also traverse the rejections of claims 14-20 under 35 U.S.C. § 102(b) as being clearly anticipated by Obradovich. Applicants submit that claims 14-20 are allowable by virtue of their dependence from independent claim 13 as well as on their own merit.

Provisional Obvious-Type Double Patenting Rejections

Claims 1-20 were provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-20 of co-pending Application No. 09/740,373. Applicants have submitted herewith a Terminal Disclaimer To Obviate A Provisional Double Patenting Rejection Over A Pending Second Application with respect to pending application 09/740,373. Therefore, Applicants respectfully request that the provisional double patenting rejections be withdrawn.

CONCLUSION

Applicants respectfully request a Notice of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,



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